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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,638	03/29/2004	W. Matthew Fender	47399-0095	2384

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AKRON, OH 44308

EXAMINER
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NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/811,638	Applicant(s) FENDER ET AL	
	Examiner Nathan M. Nutter	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-26 and 36-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 January 2006 has been entered.

### ***Response to Amendment***

In response to the amendment of 25 January 2006, the following is being placed in effect.

The rejection of claims 13-26 and 36-45 under 35 U.S.C. 103(a) as being unpatentable over Goto et al in view of Meyer et al and Williams et al is hereby expressly withdrawn.

The following new grounds of rejection are being presented.

### ***Claim Interpretations***

The recitations in the claims of "said chlorinated resin functioning as both an internal and external lubricant, thereby reducing the amount of lubricant/processing aids and coupling agents by substitution of at least a portion thereof with said chlorinated resin," is deemed to be drawn to the inherency of the addition of the chlorinated resin, and would occur universally. Nothing unexpected would be seen in a composition disclosed as such.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-26 and 36-46 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The identities of the components of the recited "cellulose and thermoplastic composite" critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claims recite "adding between approximately 0.1% to 10% by weight of a chlorinated resin." The claims fail to recite specifically to what the chlorinated resin is added to and specifically what the range "0.1% to 10% by weight" is in relation.

Claims 13-26 and 36-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for chlorinated paraffin waxes, does not reasonably provide enablement for "chlorinated resins," as recited. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or the invention commensurate in scope with these claims. The Specification shows reasonable support only for the chlorinated paraffin waxes at the paragraph bridging page 4 to page 5. To determine what other resins would be suitable would require the undue burden of experimentation on the part of an artisan.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-26 and 36-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in the claims of "adding between approximately 0.1% to 10% by weight of a chlorinated resin" fails to clearly recite to what this may be added or to what specifically the range "0.1% to 10% by weight" is in relation. As such, the instant claims are deemed to be vague and confusing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-26 and 36-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (US 4,659,754), Castagna et al (US 5,075,359), Fujita et al (US 4,737,532) or Hendrickson et al (US 6,682,814), all newly cited.

The patents to Edwards et al (US 4,659,754), Castagna et al (US 5,075,359), Fujita et al (US 4,737,532) and Hendrickson et al (US 6,682,814) each show the manufacture of a cellulose-resin composite to which may be added a chlorinated resin.

In Edwards et al and Castagna et al, the use of a chlorinated paraffin wax is taught. Note in Edwards et al at the paragraph bridging column 3 to column 4. Further, note column 2 (line 26) to column 3 (line 2) for the various thermoplastic resins

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employed, and column 3 (lines 3 et seq.) for the use of cellulose. The process is shown essentially at column 5 (lines 1-35) and the Examples, as well as compositional limitations which appear to be within those recited. In Castagna et al, note the paragraph bridging column 2 to column 3 for the chlorinated paraffin wax, column 3 (lines 19 et seq.) for the cellulose component and the paragraph bridging column 4 to column 5 for the resin. The Abstract teaches the compositional limitations to be within those recited herein.

The references to Fujita et al and Hendrickson et al both show the cellulose resin mixture, but both employ polyvinyl chloride for the chlorinated resin. Note in Fujita et al the Abstract, which also shows the compositional limitations, column 2 (lines 16-63) for the resin and column 2 (lines 11-15) for the PVC. In Hendrickson et al, note column 3 (lines 37-55) and column 12 (line 43) to column 13 (line 30) for the constituents.

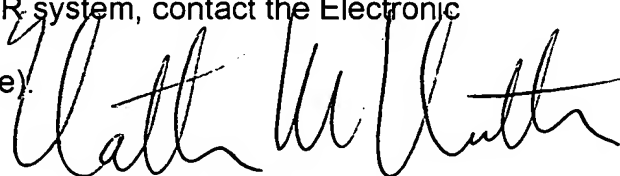
Each of the references teaches essentially what is positively recited herein for inclusion and at a level of inclusion commensurate in scope thereto. The constituents are shown to be conventional, used in their art-recognized capacities. Nothing unexpected or surprising has been shown on the record with regard to the chlorinated resin or amount of inclusion thereof. As such, the instant claims are deemed to be obvious over the teachings of either Edwards et al, Castagna et al, Fujita et al or Hendrickson et al (US 6,682,814) in the sense of 35 USC 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

3 April 2006